



October 2018



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The October 2018 issue of Sterne Kessler's MarkIt to Market® newsletter discusses how the USPTO determines similarity to prior-filed marks, the considerations of protecting a mark in a foreign language, and the new gTLD Sunrise Periods.

Sterne Kessler's [Trademark & Brand Protection practice](#) is designed to help meet the intellectual property needs of companies interested in developing and maintaining strong brands around the world. For more information, please contact [Monica Riva Talley](#) or [Tracy-Gene G. Durkin](#).

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By: [Lauriel Dalier](#) and [Monica Riva Talley](#)

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By: [Julie Shirk](#)

Babbel.com has estimated that of the world's approximately 7.5 billion inhabitants, 1.5 billion speak English, about 20% of the earth's population. English is by far the most commonly-studied foreign language, and even in countries where English is not the dominant spoken language, it is often an official language of a country's government. That said (in English or otherwise), the world is an increasingly global marketplace, and brand owners would be wise to at least consider registering their Latin script marks in the language of important foreign markets, or in countries where brand-rights squatting is likely to occur.



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As first reported in our December 2013 newsletter, the first new generic top-level domains (gTLDs, the group of letters after the "dot" in a domain name) have launched their "Sunrise" registration periods. Please contact us or see our December 2013 [newsletter](#) for information as to what the Sunrise Period is, and how to become eligible to register a domain name under one of the new gTLDs during this period.

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When examining trademark applications, the United States Patent and Trademark Office (USPTO) considers whether the applied-for mark is confusingly similar to any registered or prior-filed marks by applying the following thirteen factor-test established in *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973):

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression.
2. The similarity or dissimilarity and nature of the goods or services as described in an application or registration, or in connection with which a prior mark is in use.
3. The similarity or dissimilarity of established, likely-to-continue trade channels.
4. The conditions under which and buyers to whom sales are made, i.e. 'impulse' vs. careful, sophisticated purchasing.
5. The fame of the prior mark (sales, advertising, length of use).
6. The number and nature of similar marks in use on similar goods.
7. The nature and extent of any actual confusion.
8. The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
9. The variety of goods on which a mark is or is not used (house mark, 'family' mark,

product mark).

10. The market interface between applicant and the owner of a prior mark. . . .
11. The extent to which applicant has a right to exclude others from use of its mark on its goods.
12. The extent of potential confusion, i.e., whether de minimis or substantial.
13. Any other established fact probative of the effect of use.

If the USPTO determines that the similarities of the marks, the covered goods/services, the channels of trade, and the targeted customers overlap sufficiently, it will issue a preliminary refusal of registration. However, at the time of examination, the record typically contains no evidence that would cause the USPTO to consider other factors in support of registration. It is up to the applicant to provide this information in its response. These arguments and evidence should address as many of the 13 factors as possible, including the overall differences in the marks, any dominant terms or features in the marks, the exact nature of the goods and/or services, the channels of trade or industries, the conditions under which buyers purchase the respective goods, and any other established fact probative of the effect of use – the 13th factor.

Just in time for Halloween, the 13th factor becomes a more useful and even a “lucky” tool for applicants who own prior registration(s) similar to a cited mark. As of today, October 31, 2018, the USPTO’s Trademark Manual of Examining Procedure (TMEP) will be amended to clarify that, when determining whether to refuse registration of an applicant’s mark on the ground of likelihood of confusion with a registered mark, Examining Attorneys should also carefully consider:

1. whether [an] applicant’s prior-registered mark is the same as the applied-for mark or is otherwise not meaningfully different;
2. whether the identifications of goods and/or services in the application and applicant’s prior registration are identical or identical in part; **and**
3. the length of time the applicant’s prior registration has coexisted with the registration being considered as the basis for the likelihood of confusion refusal.

Previously, TMEP Section 1207.01 stated that the decision to issue a likelihood of confusion refusal based on a prior registration had to be weighed against the coexistence of the cited owner’s registration and the applicant’s registration ***as long as the applicant’s prior registration has coexisted with the other registration for at least five years***. As of this morning the new TMEP guidelines do away with the specific five year coexistence requirement. Instead, any duration of coexistence should be considered along with all other relevant factors.

The update to the USPTO’s consideration of coexistence reflects both the realities of today’s market in which the confluence of technologies means that more goods/services overlap, while recognizing that brands that have long coexisted in their respective spaces may continue to do so even as their offerings evolve.

In other words, the 13th factor may become “lucky” for applicants wrestling with how to demonstrate marketplace realities to the USPTO, so applicants should consider claiming ownership of prior registrations at the time of filing.

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Babbel.com has estimated that of the world's approximately 7.5 billion inhabitants, 1.5 billion speak English, about 20% of the earth's population.^[1] English is by far the most commonly-studied foreign language, and even in countries where English is not the dominant spoken language, it is often an official language of a country's government. That said (in English or otherwise), the world is an increasingly global marketplace, and brand owners would be wise to at least consider registering their Latin script marks in the language of important foreign markets, or in countries where brand-rights squatting is likely to occur.

Many of the considerations at play for protecting a mark in a foreign language are similar to those for an English-language mark. There are some key differences, though, so before taking your brand abroad in a foreign language, consider the following:

1. English to _____, and what does it mean?

First and foremost, determine what your mark will be translated or transliterated to in the foreign language of interest. What may be a harmless term in English could be vulgar, offensive, or otherwise completely off-message in another language. We all know the cautionary tale of the NOVA mark for one of Chevrolet's cars – it fared poorly in Spanish-speaking countries because the model name literally translated to "it does not go."

This may be particularly challenging in Asian countries, such as Japan, which has a phonetics-based system of writing, or in China, which has a language comprised of characters having both sound and meaning. For example, a number of spellings are possible for marks in Japanese, so take the opportunity, pre-adoption, to consider how consumers will pronounce your mark with respect to context-specific marketing communications and the like.

Similarly, because Chinese characters have an associated meaning, an English language mark

will assume the meaning of the characters to which it is transliterated. That meaning may be direct, relatively comprehensible, or completely nonsensical. For example, before the Coca Cola Company launched its beverage in China, local retailers were using a transliteration of the COCA COLA mark that meant “bite the wax tadpole.” The company ultimately landed on “K’o K’ou K’o Lê,” which means “permitting the mouth to rejoice” in Mandarin.^[2] The same applies to marks with numerals. In Chinese culture, e.g., the number 8 is considered auspicious, because its transliteration sounds similar to “fa,” the word meaning fortune. The number 4, on the other hand, is sometimes avoided due to its aural similarity to the word for death.

Regardless of language, the take-away here is to choose a translation/transliteration of the mark that conveys the appropriate message of the brand.

2. Search

Once you’ve decided on the proper translation or transliteration to be used, confirm that it is available for use and registration by searching relevant trademark registers, domain names, and common law databases. The level of searching appropriate for a foreign language mark is often dictated by budget, so you may want to vary the level of searching commensurate with the period of expected use and importance of the mark to the product/service portfolio as a whole. While most trademark counsel have access to foreign trademark records to conduct at least a preliminary search, consider an opinion by trademark counsel in the country of interest, particularly if the foreign language mark is for a product or service of great value to the company.

3. File, and file early in the “race” countries

If the foreign language mark is available, it’s best not to delay filing to register it, especially if you intend to do business in the short term, and the country of interest has a first-to-file system. Unlike the common law system in the U.S., where trademark rights accrue through use, in many foreign jurisdictions, whoever files an application first secures rights to the mark. Filing, like searching, may be restricted by budgets, so consider filing an application for only core goods and services associated with the mark, rather than all offerings under the mark. By applying early, you may prevent a bad actor from obtaining priority over any application filed by you and squatting on your mark, which could prevent you from entering the foreign market, or cost you sums to gain possession of the foreign language mark. And once your foreign language mark is registered, consider recording it with the local customs office to block the importation/exportation of infringing goods bearing the mark.

4. Register domain names

Akin to an English-language mark, consider domain name registrations for your foreign language mark, including domains in the relevant country code. This, too, could thwart the actions of unscrupulous characters looking to hold your foreign language mark for ransom.

5. Include in agreements

Once you’ve selected and filed on your foreign language mark, be sure to include it in agreements with local distributors, licensees, and dealers, taking care to include provisions on proper use, enforcement, and ownership.

6. Control the message

Finally, consider a brand use guide to control the message conveyed by your foreign language mark, and distribute this guide to those who are authorized to use it. This may be particularly

helpful in countries where local laws require translations of marks and other information in advertising.

This is a high-level list of some of the more important considerations for adoption and use of a foreign language mark, but there are others. With some thoughtful planning and protection, your brand should be able to garner recognition in a foreign language without it getting lost in translation.

[1] <https://www.babbel.com/en/magazine/how-many-people-speak-english-and-where-is-it-spoken/>

[2] <https://www.coca-colacompany.com/stories/bite-the-wax-ta>

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As of October 31, 2018, ICANN lists new Sunrise periods as open for the following new gTLDs that may be of interest to our clients. A full list can be viewed at: <https://newgtlds.icann.org/en/program-status/sunrise-claims-periods>.

.sport	.fan
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ICANN maintains an up-to-date list of all open Sunrise periods [here](#). This list also provides the closing date of the Sunrise period. We will endeavor to provide information regarding new gTLD launches via this monthly newsletter, but please refer to the list on ICANN's website for the most up-to-date information – as the list of approved/launched domains can change daily.

Because new gTLD options will be coming on the market over the next year, brand owners should review the list of new gTLDs (a full list can be found [here](#)) to identify those that are of interest.

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